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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,142	11/15/2000	Reinhard Ebner	1488.0630002/KRM	4465

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Sterne Kessler Goldstein & Fox PLLC
Suite 600 1100 New York N.W.
Washington, DC 20005-3934

EXAMINER

ROMEO, DAVID S

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 10/21/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/712,142

Applicant(s)

EBNER ET AL.

Examiner

David S Romeo

Art Unit

1647

--Th MAILING DATE of this communication app ars on th cover sheet with th correspondence address --

THE REPLY FILED 19 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 19 August 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The term "specifically binds" would require further consideration.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 24-67.

Claim(s) withdrawn from consideration: 7.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


David S Romeo
Primary Examiner
Art Unit: 1647

Continuation of 5. does NOT place the application in condition for allowance because: Claims 24-67 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. Claims 24-67 are also rejected under 35 U.S.C. 112, first paragraph. Applicant argues that the examiner has not met his burden. Applicant's arguments have been fully considered but they are not persuasive. The specification at pages 31-32 indicates that CTGF-3 expression can be either enhanced or increased in connective-tissue related disorders. The asserted utilities are not specific and substantial. Although the present specification does not list colon tumors as one of the types of cancers that could be detected by an increase in expression of CTGF-3, colon tumors are a form of cancer. A deficiency under 35 U.S.C. 101 also creates a deficiency under 35 U.S.C. 112, first paragraph.

Claims 36-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 36-46 are indefinite because they recite the term "mature." Applicant's arguments have been fully considered but they are not persuasive. The specification at page 8, line 12, to page 9, line 28, intends the term "mature" to encompass the mature form produced by expression in a mammalian cell. The instant specification does not identify that material element or combination of elements which is unique to, and, therefore, definitive of "mature". The metes and bounds are not clearly set forth. It is suggested that the claims recite "the polypeptide lacking its signal sequence".

Claims 57-67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Applicant's arguments have been fully considered but they are not persuasive. Although, typically, inoperative embodiments are excluded by language in a claim (e.g., preamble), the scope of the claim may still not be enabled where undue experimentation is involved in determining those embodiments that are operable. A disclosure of a large number of operable embodiments and the identification of a single inoperative embodiment did not render a claim broader than the enabled scope because undue experimentation was not involved in determining those embodiments that were operable. However, claims reading on significant numbers of inoperative embodiments would render claims nonenabled when the specification does not clearly identify the operative embodiments and undue experimentation is involved in determining those that are operative. In the present case, the specification does not clearly identify the operative embodiments. It is this additional characterization that is required to practice the claimed invention that constitutes undue experimentation

Claims 57-67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicant's arguments have been fully considered but they are not persuasive. The claims are directed to a genus of nucleic acid molecules encoding a genus of polypeptides wherein the genus of polypeptides has a genus of mitogenic activities. The specification and claim do not indicate what distinguishing attributes are shared by the members of the genus that have the desired activity. Thus, applicant was not in possession of the claimed genus.

Claims 57-76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicant's arguments have been fully considered but they are not persuasive. The fact that a polypeptide may bind an antibody says nothing regarding the function of the polypeptide. The specification and claim do not indicate what distinguishing attributes shared by the members of the genus. The specification and claim do not provide any guidance as to what changes should be made. No common structural attributes identify the members of the genus. Since the disclosure fails to describe the common attributes or characteristics that identify members of the genus, an antibody that is specific for SEQ ID NO: 2 is insufficient to describe the genus. One of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe the genus. Thus, applicant was not in possession of the claimed genus.

Claims 57-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 57-67 are indefinite because they recite the term "having specificity for". Applicant's arguments have been fully considered but they are not persuasive because the arguments are directed to the proposed amendment and that amendment has not been entered.